

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Lex P. Jansen, et al.

Serial No.: 10/623,381

Filed: July 18, 2003

**For: BIOCOMPATIBLE WIRES AND
METHODS OF USING SAME TO
FILL BONE VOID**

)
) **Confirmation No.:** 3194

)
) **Group Art Unit:** 3738

)
) **Examiner:** Willse, David H.

REPLY BRIEF-37 CFR §41.41

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Brief is in reply to the Examiner's Answer, dated November 2, 2007.

Appellant agrees with the statements made in item numbers (1)-(8) and (11) of the Examiner's Answer, and responds to the statements made in item numbers (9) and (10) of the Examiner's Answer as follows:

As an initial matter, the Examiner has essentially provided a new basis for rejection by introducing several references (i.e., U.S. Patent No. 4,405,249 ("Scales"), U.S. Patent No. 6,241,734 ("Scribner"), and U.S. Patent Publication No. 2004/0153090 ("Vandewalle")) into evidence for the purpose of showing that it was known to use bone cement spraying devices. The Examiner apparently felt warranted to introduce this new evidence, since Appellant did not raise the issue of the bone cement spraying device

until after the final office action. In doing this, however, the Examiner has wrongly placed the onus for this new introduction of evidence on Appellant. Appellant is not forbidden from presenting arguments in an appeal that were not made prior to the issuance of a final office action. Indeed, it is the Examiner's obligation to support all rejections made during the prosecution of the application, and if Appellant has pointed out the insufficiency of a rejection during an appeal, Appellant should not somehow be placed at a disadvantage because of this.

Turning to the substance of the Examiner's Answer, the Examiner first stated, apparently in reference to Appellant's argument that filling of a bone space or site is disadvantage, that neither claim 25 nor claim 31 excludes the filling of a bone space or site with bone cement. While Appellant agrees that claims 25 and 31 do not exclude the filling of a bone space or site with bone cement, the test for obviousness is not whether a claim excludes a prior art combination or modification of the prior art. In fact, the Examiner simply has not shown why it would be obvious to use a spraying device to fill a bone space or site with bone cement—especially since it would appear to be more efficient to use other instrumentalities to fill a bone space or site. To the extent that it is the Examiner's position that it would be obvious to use a spraying device to fill a bone void in order to minimize the incision size, the Examiner has not provided any reasoning or evidence that a bone cement spraying device has a lower profile than does any other device that percutaneously delivers bone cement.

Furthermore, although the Examiner has stated that the pressurized injection of bone cement through confined passageways had been known in the art for decades, the claims require more; that is, a spraying device for applying bone cement or the step

of spraying a bone cement. The fact that some of these references disclose the pressurized injection of bone cement through confined passageways, which was clearly disclosed in the background of the invention as having disadvantages (see page 1, line 20 to page 2, line 4 and page 2, line 20 to page 3, line 12 of specification), is not that same as spraying the bone cement, even assuming that the Examiner's definition of the term "spraying" (i.e., a fine jet of liquid discharged from a pressurized container") is true.

In particular, Scales discloses a device for ejecting bone cement from a syringe (see col. 16, lines 43-46), but does not disclose that the bone cement is sprayed. In fact, the bone cement is described as a viscous paste that will not pass through apertures in the range of 1.5-3.0 mm (see col. 16, lines 35-42), so it is difficult to fathom how Scales discloses that the bone cement is sprayed. Scribner does not disclose that bone cement is sprayed, in fact, discloses that opposite; that is, the bone cement flows from the device in a stream into the bone cavity (see col. 16, lines 14-21). Thus, these references show nothing more than what described in the background of the invention—that it, it was known to percutaneously inject bone cement into a bone cavity.

Vandewalle does disclose that a material can be sprayed into a bone cavity, but this material is a platelet concentrate—not a bone cement (see paragraph [0017]). In fact, the Examiner has not shown that Vandewalle is a prior art reference, since it was published well after the filing date of the present application, and the claimed subject matter was invented prior to the filing date of the Vandewalle application (although, given that the Examiner just cited Vandewalle, Applicant was not given the opportunity

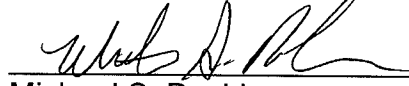
to show that the claimed subject matter was invented prior to the filing date of
Vandewalle).

Respectfully submitted,

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Dated: January 2, 2008

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